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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,724	08/20/2003	Paul Edwin Jones	2705-283	1756
20575 7590 06/09/2009 MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204				
EXAMINER				
JUNTIMA, NITTAYA				
ART UNIT		PAPER NUMBER		
2416				
MAIL DATE		DELIVERY MODE		
06/09/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/645,724

**Applicant(s)**

JONES ET AL.

**Examiner**

NITTAYA JUNTIMA

**Art Unit**

2416

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-36 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-36 and 38-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is in response to the amendment filed on 3/11/2009.
2. **Claims 1-11, 13-36, and 38-42** are pending (claims 12 and 37 were canceled).

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim(s) 5-20** is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The method **claims 5 and 15** including steps of ... is broad enough that the claim could be completely performed mentally or manually without a machine nor is any transformation apparent. It is suggested that the claims be rewritten such that at least one method step is performed by a particular machine.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims **1-11, 13-36, and 38-42** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In **claim 1**, the claim includes a delay point that indicates both call completion on busy *and* call completion on no answer (note that "the call supplement services" in line 7 refers to "call supplementary services" in line 7, and "the delay point" in lines 6-7 refers to "delay point" in line 6 of the claim). The specification (page 7, lines 21-23) specifically discloses that a delay point, DP, is the point at which all of the conditions are satisfied, then the delay point in claim 1 which indicates that the two conditions, i.e., (i) call completion on busy *and* (ii) call completion on no answer, must be met before the call can be established (that is alerting the called user or prematurely releasing the call before alerting, specification, page 1, lines 4-9). However, in an actual call, a condition of either call completion on busy OR call completion on no answer can happen, not both. Therefore, the specification fails to disclose how, within the same call, a delay point at which both call completion on busy and call completion on no answer are supported.

In **claims 5, 9, 14, 15, 19, 20, 21, 26, 27, 29, 30, 31, 35, 36, 40, and 42**, the claims similarly recite that the delay point indicates feature discovery of the called endpoint and call supplementary services.

However, referring to Fig. 4 which discloses a call flow diagram for delayed call establishment for maintenance purposes without involves any user notification and that the delay point is when bidirectional media is established (see specification, page 8, lines 15-17 and 21-22, page 9, lines 18-20 and page 10, lines 1-6) which presumably corresponds to the claimed "feature discovery of the called endpoint." On the other hand, Fig. 5 discloses a call flow diagram for delayed call establishment in a call back busy signal situation which involves user notification and that the delay point is identified as explicit notification (see specification, page 8, lines 17-20, page 10, lines 9-21). Therefore, Fig. 4 for call delay establishment with feature discovery/maintenance purposes without involving user notification and Fig. 5 for call delay establishment in a CCBS involving user notification are disclosed as two mutually exclusive embodiments.

In addition, since the specification (page 7, lines 21-23) discloses that a delay point, DP, is the point at which all of the conditions are satisfied, then the delay point in **5, 9, 15, 20, 21, 26, 27, 30, 31, 35, 36, 40, and 42** which indicates that multiple conditions, i.e., mainly two groups (i) feature discovery of a called endpoint/maintenance testing and (ii) call supplementary services including call completion on busy and call completion on no answer, must be met before the call can be established (that is alerting the called user or prematurely releasing the call before alerting, specification, page 1, lines 4-9). However, in an actual call, as for call supplementary services, either condition of call completion on busy OR call completion on no answer can happen, not both.

Therefore, the specification fails to disclose how the system can have and will behave in an actual call setup in which the DP indicates both the conditions that require notifying the user/called endpoint and the conditions that do not require notifying the user/called endpoint.

In **claim 38**, the claim includes the delay point that also indicates diagnostic testing without alerting a user of the called endpoint which corresponds to Fig. 4 (specification, page 9, lines 18-page 10, lines 1-6); however, the delay point in claim 1 on which claim 38 depends indicates call supplementary services that include call completion on busy and call completion on no answer which involve notifying the called endpoint and correspond to Fig. 5 (specification, page 5, lines 10-19 and page 10, lines 7-21).

Therefore, since the specification (page 7, lines 21-23) discloses that a delay point, DP, is the point at which all of the conditions are satisfied, the specification does not disclose how the system can have and will behave in an actual call setup in which the DP indicates both the conditions that require notifying the user/called endpoint and the conditions that do not require notifying the user/called endpoint. In addition, claims 1 and 38 are two mutually exclusive embodiments and should be claimed separately.

#### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1 and 5 have been considered but are moot in view of the new ground(s) of rejection.

A. In the remarks on pages 11-13, it is clear in the claims what are being claimed. However, it is respectfully submitted that the features that are claimed, i.e., delay point including call completion on busy and call completion on no answer, delay point including both feature

discovery of the called endpoint and call supplementary services including call completion on busy and call completion on no answer, are not disclosed and supported by the specification. Specifically, the examiner agrees with the applicant's remark on page 12 that the delay point may be the point at which multiple conditions are satisfied; however, it is to be noted that the specification also indicates that the delay point is also the point at which all of the conditions are satisfied which means all the claimed conditions, namely, a combination of call completion on busy and call completion on no answer as claimed in claim 1 and a combination of feature discovery of the called endpoint not involving alerting the user/called endpoint and call supplementary services including call completion on busy and call completion on no answer and involving alerting the user/called endpoint as claimed in claim 5, must be met before a call can be established, i.e., alerting the called user or prematurely releasing the call before alerting (specification, page 1, lines 4-9). But such combinations of no answer and busy signal in the same call and combinations of conditions involving alerting the user/ called endpoint and conditions not involving alerting the user/called endpoint in the same call are not disclosed anywhere in the specification. Therefore, claims **1-11, 13-36, and 38-42** are now rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

### *Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NITTAYA JUNTIMA whose telephone number is (571)272-3120. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571.272.3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nittaya Juntima/  
Examiner, Art Unit 2416  
6/5/2009